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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/253,831	02/19/99	ROBERTS M	9329-001C01

TM11/1011

HARNES DICKEY & PIERCE
P O BOX 828
BLOOMFIELD HILLS MI 20016

EXAMINER	
HO, T	
ART UNIT	**PAPER NUMBER**
2612	11

DATE MAILED: 10/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.	Applicant(s)
09/253,831	Roberts et al
Examiner	**Group Art Unit**
Tuan Ho	2612

☒ Responsive to communication(s) filed on *Jul 18, 2000*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *21-31* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *21-31* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Applicant's arguments filed 7/18/00 have been fully considered but they are not persuasive.

With regard to claims 21-26 and 28-30, Applicants argue that Sasson does not teach or suggest a control unit for initialization of memory element. In response to the arguments, examiner takes a broad interpretation and notes that since the term "initialization of a memory element" does not includes any limitation how to initialize a memory element, the term is interpreted as discussed in col. 5, lines 39-55 of Sasson; wherein the verification and setting code patterns are considered as a initialization step.

Applicants' argument of claim 31 are persuasive; therefore, the rejection of claim 31 over Sasson has been withdrawn.

For the above reasons, claims 21-26 and 28-30 are rejected again.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because figures shown in the same abstract page are extraneous and should be deleted and the abstract does not describe the present invention. Correction is required. See MPEP § 608.01(b).

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

Claims 21-31 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 5,138,459 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The reason was discussed in paragraph 4 of thr last Office action.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 21-26 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasson et al (US Patent No. 5,016,107).

With regard to claim 23, Sasson et al discloses in Fig. 1A, an electronic still camera which comprises the same operator selectable control switch (control processor 20 controls the camera operation upon receiving a signal form a shutter release switch, col. 9, line 17), sensor 12 and A/D converter 16), memory means (memory card 24), programmable control unit (control processor 20), routine (processor 20 checks memory status, col. 5, lines 24-68), steps of checking status information (col. 5, line 45+), checking the presence of the memory (col. 5, line 39+), checking for initialization of the memory (col. 5, lines 45-50), checking a capacity (col. 5, line 45), and determining an available number of image frames as claimed (col. 5, lines 40-45).

With regard to claim 24, Sasson et al discloses in Fig. 1A, an electronic still camera which comprises the same means for displaying as claimed (operation display 30).

With regard to claim 25, Sasson et al discloses in Fig. 1A, an electronic still camera which comprises the same programmable control unit (control processor 20, col. 5, lines 40-55).

With regard to claim 26, Sasson et al discloses in Fig. 1A, an electronic still camera which comprises the same means for periodically repeating the checking of the switch status (in response to a shutter switch, processor 20 checks the status of the memory, col. 5 and col. 9, lines 18+).

With regard to claim 28, Sasson et al discloses in Fig. 1A, an electronic still camera which comprises the same electric power supply (a power supply such as batteries is inherently included in the electronic camera of Sasson et al; otherwise, a user cannot carry the camera around for taking pictures), the steps of sensing power up and checking an output level of the power supply (processor 20 is activated by a shutter release switch only after the power is up and if no power supply is present, the camera would not work).

Claims 29 and 30 recite what was previously discussed with respect to claims 26 and 24.

With regard to claim 21, Sasson et al discloses in Fig. 1A, an electronic still camera which comprises the same removable digital memory element (memory card 24), display (operation panel 30) and user control (shutter release switch and processor 20).

Claim 22 recites what was discussed with respect to claim 23.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasson et al (US Patent No. 5,016,107) in view of Sasaki et al (US Patent No. 5,034,804).

Sasson et al discloses the same subject matter as discussed with respect to claim 23, except for operator selectable control switch capable of assuming a plurality of setting including a color/black and white selection, a resolution mode and compression mode settings.

Sasaki et al does not explicitly disclose any control switch including the settings. However, Sasaki et al disclose in Figs. 6A and 6B, an electronic still camera which comprises a mode setting switch 12. Mode switch 12 is able to set image recording at high or low resolution, color, col. 4, lines 58-68 and col. 5, lines 1-12. The use of the mode switch would allow a user to control image quality and a number of frames recorded in a memory (col. 4, line 58-68).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the processor 20 and operation panel 30 of Sasson et al in the same manner of Sasaki et al in order to set the camera at color mode, resolution mode and compression mode and thereby to improve the camera versatility.

With regard to Black and white setting mode, it is noted that Black and White mode is a mode in which the camera can record color image with only a Y signal (Official Notice is taken for a Y-signal or luminance signal) . Since a Black and White image contains less data than a color image, the recording would allow a user recording more pictures in the memory. As a result, more pictures can be recorded with a certain memory card, and that would improve the camera operation in overall.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the camera circuit of Sasson et al in view of Sasaki et al so as to record a Black and White image and thereby to improve the camera versatility.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306 and (703) 308-6296 (for formal communications intended for entry)

Or:

(703) 308-5399 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Ho whose telephone number is (703) 305-4943. The examiner can normally be reached on Monday-Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

TH

October 8, 2000

TUAN HO
PRIMARY EXAMINER